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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,145	02/17/2004	John S. Erickson	P0935	6057

23735 7590 09/08/2004

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EXAMINER	
CALLAHAN, PAUL E	

ART UNIT	PAPER NUMBER
2137	

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/781,145	ERICKSON, JOHN S.	
	Examiner	Art Unit	
	Paul Callahan	2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 February 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *8-12 and 14* is/are allowed.

6)☒ Claim(s) *1-7 and 13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _____ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-14 are pending in this application and have been examined.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 2 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 contains the passage "...renders the content..." The meaning of "render" is not clear in this context. The Applicant may wish to change the term to "opens" or a similar term indicating that the application program acts on the data in such a way as to make it readable by the user.

Claim 7 contains the passage "...content rendering application..." The meaning of "render" is not clear in this context. The Applicant may wish to change the term to "displaying" or a similar term indicating that the application program acts on the data in such a way as to make it readable by the user.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 4, 5, and 13 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Earnest, US 4,888,798.

As for claim 1, Earnest teaches a method for protecting electronic media (abstract) comprising: encrypting the media (abstract) transmitting the encrypted media, together with data indicating a first set of permissions (col. 2 lines 60-67) to a user device; decrypting and using the electronic media at the user device in accordance with the first set of permissions (col. 3 lines 1-22); sending a signal from the user device requesting additional permissions (col. 3 lines 10-15); receiving at the user device data representing additional permissions (col. 3 lines 10-15); and using the electronic media at the user device in accordance with the additional permissions (col. 3 lines 10-15).

As for claims 13, the claim is identical to claim 1 save for the additional limitations of the electronic media being a "content object containing text" and use of the electronic media constituting performing a function using said content. A reasonably broad interpretation of "electronic media" and it's use, as taught by Earnest, includes the content object and performing a function using it as recited by claim 13. Therefore claim 13 is rejected on the same basis as is claim 1.

As for claim 4, Earnest teaches a method for protecting electronic media (abstract) comprising: storing encrypted media on a user device (col. 2 lines 60-67); receiving a request to utilize the media in a first manner (col. 3 lines 1-22); checking first license data on the user device to determine the whether the use of the stored media in the first manner is authorized (col.

3 lines 28-35); and if not, contacting a remote server, performing a licensing transaction wit the remote server resulting in issuance of second license data; storing the second license data on the user device, and decrypting the media for use (col. 3 lines 10-15).

As for claim 5, Earnest teaches informing the user if checking determines that use of the stored media in the first manner is not authorized, prior to contacting a remote server for a second permissions set (col. 8 lines 33-44, col. 12 lines 1-8).

6. Claim 7 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by CrypKey SDK ™, CrypKey.com, 1992. The CrypKey SDK™ application, developed by CrypKey (Canada) Inc. in 1992, is a rights management software development kit used to modify an application by software developers, in accordance with the CrypKey SDK software kit, to impart rights management functionality to an application. CrypKey SDK therefore clearly anticipates the Applicants claim 7.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Earnest as applied to claim 1 above and Moore US 5,343,527.

Earnest teaches the limitations of claim 1 upon which clam 2 depends, but does not teach a server that computes a one way hash function on data representing the content, yielding hash data, then encrypting the hashed data, transmitting the hash data to the user, wherein the application program then checks the authenticity of the delivered content by reference to the encrypted hash data. Moore does teach these steps (fig. 3, fig. 4, fig. 6 see esp. item 617 "Comparator"). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the system of Ernest. It would have been desirable to do so as this would increase the security of the data transport in Earnest. Motivation to make this combination can be found, for example in col. 8 lines 34-40 where authentication of a copy of a software program is discussed.

8. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Earnest and Moore as applied to claim 1 and 2 above, and further in view of Schneier; "Applied Cryptography 2nd Edition, John Wiley & Sons Ed., Oct. 1995, pages. 38-39.

The combination of Earnest and Moore does not teach the feature found in claim 3 of encryption of hashed data by use of a key associated with a user. However Schneier does teach this feature on page 38-39. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the system of Earnest and Moore. Moore discusses the desirability of making this combination, for example, in col. 8 lines 34-40 where authentication of a copy of a software program is discussed.

9. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Earnest as applied to claim 1 above, and Halter et al. US 5,319,705.

Earnest fails to teach transmission of a second set of license information encrypted under a key associated with an intended licensee. Halter does teach transmission of license information under such a key in col. 9 lines 1-15. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the system of Earnest. Motivation to make this combination may be found, for example, at the abstract where maintain "central control" over which elements of electronic media are unlocked is discussed. Encryption of license information under a key associated with a user-licensee would facilitate this end.

Allowable Subject Matter

10. Claims 8-12 and 14 are allowed.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul E. Callahan whose telephone number is (703) 305-1336. The examiner can normally be reached on M-F from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Caldwell, can be reached on (703) 306-3036. The fax phone number for the organization where this application or proceeding is assigned is: (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Paul Callahan
9/2/04